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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/439,052	11/12/1999	KELVIN RODERICK LAWRENCE	AT9-98-146	1180

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EXAMINER

WONG, LESLIE

ART UNIT PAPER NUMBER

2177

DATE MAILED: 11/27/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/439,052

Applicant(s)

LAWRENCE ET AL.

Examiner

Leslie Wong

Art Unit

2177

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 12 November 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 November 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: elements 12 and 28 in Fig. 1. Correction is required.
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: elements 204 and 205 in Fig. 2. Correction is required.
3. The drawings are objected to under 37 CFR 1.83(a) because they fail to show a control flow and a label for a decision in box 307 as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Correction is required.

### ***Specification***

4. The disclosure is objected to because of the following informalities: the word "nay" is misspelled on page 8 line 21. Appropriate correction is required.
5. When acronyms are used, they should be defined upon first use. In the specification, there are instances where an acronym is used and never defined. See page 6, line 9 "CPU" and line 23 "VRT". See 35 USC 112(1) and 37 CFR 1.179(a). Correction is required.

6. The use of the trademark Yahoos<sup>TM</sup> and Alta Vista<sup>TM</sup> has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 4, 11, and 18 contain trademark/trade names Yahoos<sup>TM</sup> and Alta Vista<sup>TM</sup>

Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, trademark/trade names are used to identify/describe search engines and, accordingly, the identification/description is indefinite. Moreover, Yahoos<sup>TM</sup> and Alta Vista<sup>TM</sup> used in the

claims do not identify the version, hardware, and software requirements associated with the applications' invention.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

10. Claims 1, 3, 5-8, 10, 12-15, 17, and 19-21 are rejected under 35 U.S.C. 102(e) as being anticipated by **Ballard** (U.S. Patent 5,987,457)

Regarding claims 1, 8, and 15, **Ballard** teaches a process and method for “bookmark set” World Wide Web (Web) search and execution refinements:

- a). means for scanning output of search engine and marking Uniform Resource Locators (URLs) positive or negative, regarding meeting said URLs needs and unmarked where neutral (col. 2, lines 37-40; col. 4, lines 29-31; col. 6, lines 22-28, 35-39; Fig. 4);
- b). means of creating said “bookmark set” which contains said marked URLs with plus and minus ratings (col. 2, lines 42-47; col. 6, lines 40-45; Fig. 4);
- c). subsequently resubmitting said “bookmark set” to said search engine for weight and ranking, in said next search (col. 2, lines 48-53; col. 3, lines 26-29; col. 6, lines 54-63 and Fig. 4).

Regarding claims 3, 10, and 17, **Ballard** teaches a process and method wherein said refinements can employ any search engine (col. 2, lines 34-36; col. 5, lines 23-24 and 25-27).

Regarding claims 5, 6, 12, 13, 19, and 20, **Ballard** teaches a process and method wherein said refinements can eliminate the need to manually reformulate the search and involve an automated selection process (col. 4, lines 29-32; col. 6, lines 66-68).

Regarding claims 7, 14, and 21, **Ballard** teaches a process and method wherein said refinements employ weighted logic processes to refine the search (col. 7, lines 57-61; col. 8, lines 15-25, 27-38 and Fig. 5).

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2, 4, 9, 11, 16, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ballard** (U.S. Patent 5,987,457).

Regarding claims 2, 9, and 16, **Ballard** teaches all subject matters as claimed above.

**Ballard** does not explicitly state that refinements can be repeated as often as desired to refine the results to a manageable level.

However, Official Notice is given that users may repeat the search as many times as needed until they satisfy with the result is well known in the art at the time of the invention to narrow down the search result and obtain desirable search outputs.

Thus, it would have been obvious to one ordinarily skilled in the art at the time of the invention to anticipate users to repeat the search for query refinement as often as needed to achieve the targeted search results.

Regarding claims 4, 11, and 18, **Ballard** teaches a computer based process substantially as claimed.

**Ballard** does not teach a process wherein refinements can employ such search engines as Yahoos or Alta Vista.

However, Official Notice is given that using Yahoo™ and Alta Vista™ as search engines is well know in the art because they are widely available and also further more they are the industry standard method of performing internet searches.

Thus, it would have been obvious to one ordinarily skilled in the art at the time of the invention to employ search engines such as Yahoo™ and Alta Vista™ because they are widely available, most used, and popular search services.

***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Salmon et al.** (U.S. Patent 5,592,375) teaches a computer-assisted system for interactively brokering goods or services between buyers and sellers.

**Culliss** (U.S. Patent 6,182,068 B1) teaches a personalized search method.

**Hajime Takano and Terry Winograd** (Dynamic Bookmarks for the WWW) teach managing personal navigation space by analysis of link structure and user behavior.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie Wong whose telephone number is (703) 305-3018. The examiner can normally be reached on Monday-Friday 9:30am - 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E Breene can be reached on (703) 305-9790. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-6606 for regular communications and (703) 308-6606 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Leslie Wong  
Art Unit 2177

LW  
November 9, 2001

  
JOHN BREENE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100